

REMARKS

Claims 1-40 are currently pending in the Application.

In light of the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the Final Office Action, the Examiner rejected claims 1 and 21 under 35 USC §102(b) as anticipated by U.S. patent 5,956,015 to Hino. The Examiner also rejected claims 2-20 and 22-40 under 35 U.S.C. §103(a) as being unpatentable over Hino in view of U.S. Patent No. 6,480,202 to Deguchi et al. ("Deguchi").

Claim Rejection - 35 U.S.C. §102(b) - Hino

Applicants respectfully traverse the §102(b) rejections of claims 1-3, 5-23, and 25-40 because the Office Action fails to set forth a *prima facie* case of anticipation. In order to properly anticipate a claim, a prior art reference must disclose each and every feature of the claim.

Hino fails to disclose a number of positively recited features of claims 1 and 21. For example, nowhere does Hino contain any disclosure or suggestion of the recited image

display device including said black correction part that has (1) a black-display characteristic specifying means performing a predetermined operation to specify a black-display characteristic specifying data related to a characteristic in displaying black with said image display means; (2) a black-approximated data calculating means calculating a black-approximated data composed of said predetermined number of color data and related to at least one of luminance, chromaticity and tristimulus values in displaying black based on said characteristic in displaying black with said image display means on the basis of said black-display characteristic specifying data; and (3) a black-correction processing executing means executing said black correction processing to said image data in units of said predetermined number of color data based on said black-approximated data, to output said black-corrected image data, as recited.

Contrary to what is asserted in the rejection, Hino's controller 36 is not a black correction part at all, let alone a black color correction part with the aforementioned three positively recited characteristics.

As explained in Applicant's specification, at page 31, lines 18-24, the term "black correction" in the present

invention means a correction of black reproducibility, and is used in general for correction of "black fading" due to influence of external light and for correction of "black correction" due to the characteristic of an image display means. Hino does not directly address this concept.

Hino's controller merely converts image data based on luminance. While Hino discloses, in col. 8, lines 32-36, that when the ambient light is 600 or 900 luxes, the CRT brightness for a black color display is approximately zero, and that, in contrast, under 1900 luxes of ambient light, the CRT brightness for the black color becomes above zero. This is merely a statement of what occurs in a CRT and is not a disclosure of any means to perform black color correction. Hino has no black color correction part in general, let alone a black color correction part with the aforementioned three recited features.

Hino is merely directed to a system and method of color match between a display monitor and an image carrying substrate that displays color patches based on the luminance of a standard illuminant and, while Hino takes into consideration the difference in luminance between ambient light and that of a standard illuminant, Hino's method and system does not perform black color correction as recited in claims 1 and 21.

The Office Action appears to assert that the equation (1) generated adjusted RGB signal values are solely black corrected image data. Applicant respectfully disagrees. As pointed out above, Hino merely discusses CRT black brightness values under different values of ambient light and contains no disclosure of any mechanism for generating black corrected image data or using that data to correcting black reproducibility of an image.

Hino's controller 36 does control display output but Hino does not disclose that controller provides the aforementioned positively recited black correction part with the three specifically recites black-display characteristic specifying means, black-approximated data calculating means and black-correction processing execution means. At best, as noted above, Hino merely mentions the effect of ambient light on CRT brightness for black color display but fails to provide the recited features to provide black color correction.

Accordingly, the Office Action fails to make out a *prima facie* case that claims 1-42 are anticipated by Hino.

Claim Rejection under 35 USC §103(a) - Hino and "Deguchi"

Claims 2-20 and 22-40 stand rejected under 35 USC §103(a) as unpatentable over Hino in view of Deguchi et al. ("Deguchi"). This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the

legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior

art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Hino does not disclose or suggest the invention in claims 1 or 21, or in claims 2-20 and 22-40, which depend, respectively, from claims 1 and 21, at least for the reasons discussed above in traversing the rejection of claims 1 and 21 as anticipated by Hino.

Deguchi is not applied to provide the features recited in claims 1 and 21 that are missing from Hino. Therefore, even if it were obvious to modify Hino, as suggested, in view of Deguchi, the resulting modification of Hino would not meet nor render obvious the claimed invention recited in claims 2-20 and 22-40.

Furthermore, the Office Action has not made out a prima facie case that one of ordinary skill in the art would be

motivated to modify Hino to achieve the claimed invention in view of Deguchi.

Deguchi discloses a device and method of updating a color profile of a display monitor based on ambient light information of the visual environment of the monitor.

Deguchi discloses, with respect to description of a black correction, that if a user determines that black isolation exists (paragraph bridging cols. 26 and 27), i.e., if the monitor emits light despite input signals to the monitor are zero (col. 25, lines 11-13), the user can either not correct the black isolation (if it is determined to exist only slightly), or the black isolation can be corrected (if it is clearly observable).

Black isolation, as defined by Deguchi is the situation in which a monitor, e.g., a CRT, emits light when there are no signals to the monitor. That concept is not disclosed by Hino nor is it dealt with in any manner in Hino. Moreover, the Office Action fails to demonstrate what black isolation has to do with Hino.

Accordingly, it appears to Applicant that this combination of references is not based on any objective factual evidence of proper motivation to modify Hino in view of Deguchi but, rather,

is based on improper hindsight reconstruction of Applicant's invention based solely on Applicant's disclosure. As a result, this rejection fails to establish a *prima facie* case of obviousness of the claimed invention.

Thus, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 2-20 and 22-40.

CONCLUSION

Applicants respectfully request that this Reply under 37 C.F.R. §1.116 be favorably by the Examiner and deemed to place the Application in condition for Allowance. In view of the foregoing remarks, Applicants submit the claimed invention is not anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore respectfully request reconsideration of this Application by the Examiner, and the timely allowance of the pending claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster (Reg. No. 46,472) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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Reply to June 10, 2005 Office Action

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Pursuant to the provisions of 37 CFR §1.17 and §136(a),  
Applicants respectfully petition for a one (1) month extension of  
time for filing a reply in connection with the present application.  
The required fee of \$120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this,  
concurrent, and future replies, to charge payment or credit any  
overpayment to Deposit Account No. 02-2448 for any additional fees  
required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension  
of time fees.

Respectfully submitted,

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